

RECEIVED
CENTRAL FAX CENTER
OCT 13 2006

REMARKS

This Amendment and Response is submitted with a Request for Continued Examination under 37 CFR § 1.114.

Claims 1-10 are pending in the present Application. Claims 1, 2, 5, and 6 have been amended, and Claims 11 and 12 have been added, leaving Claims 1-12 for consideration upon entry of the present amendment.

Claims 1 and 5 have been amended to include the acid value limitation of "10 to 30 mgKOH/g", where a value of 10 mgKOH/g for the lower limit is provided in the Specification by the acid number limit for the polyester resin in the examples. Support for these amendments can be found at least in Claims 2 and 6, in the Specification on p. 14, lines 14-17, and in Example 1, p. 9, line 9. Accordingly, Claims 2 and 6 have been amended to remove corresponding overlapping limitations.

Claim 9 has been amended to correct inadvertent typographical errors.

In addition, it is noted by Applicants that Claim 10, inadvertently included as "new" in the Response filed on September 12, 2006 to the Final Office Action dated July 13, 2006, has been amended herewith to correctly present as "previously presented". Claim 10 was first entered as "new" in the Amendment and Response filed February 28, 2006, in response to the Office Action dated November 30, 2005. Claim 10 was then acknowledged and rejected over Kiefer-Liptak by the Examiner in the Final Office Action dated July 13, 2006, the rejections of which are addressed in the present Amendment and Response. Applicants therefore sincerely apologize for the inadvertent error in not changing the status of Claim 10 to "previously presented". Applicants also respectfully suggest that, in light of the entry of Claim 10 prior to the issuance of the Final Office Action dated July 17, 2006, that inclusion of Claim 10 cannot therefore correctly be cited by the Examiner as a basis for non-entry of the Response filed September 12, 2006, which reason was advanced in note 3 of the Advisory Action dated September 21, 2006; and further, that Claim 10 should therefore not require additional search as it was previously entered and specifically rejected by the Examiner in the Final Office Action dated July 17, 2006, which rejection is addressed below. Accordingly, reconsideration of the reasons for non-entry of the Amendment and Response filed September 12, 2006 is therefore respectfully requested.

Docket No. 21C-0106

No new matter has been introduced with these amendments.

New Claims

New Claims 11 and 12 have been added. Support for Claim 11 can be found at least in Claims 2 and 6 (now canceled), and in the Specification on p. 5, lines 14-17, and at least in Example 1 on p. 9, lines 23-24. Support for Claim 12 can be found at least in the Specification on p. 16, lines 12-14; Table 1 on p. 18; and p. 19, lines 6-9. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 102(e)

Claims 1-10 stand rejected under 35 U.S.C. § 102(e), as allegedly anticipated by U.S. Publication No. 2004/0044117 A1 ("Liptak"). (Office Action dated July 13, 2006). Applicants respectfully traverse this rejection.

The invention as presently amended is directed to an acryl-modified polyester resin composition produced by a polymerization of a polyester resin intermediate of formula (1) and an acryl monomer:

$$\text{R-CH}_2\text{-O-CO-CH=CH-X} \quad \text{---} \quad (1), \text{ wherein R represents a polyester polymer residue, and X represents a methyl or carboxylic group, and wherein the polyester resin intermediate has a hydroxyl value of about 1 to 20 mgKOH/g and an acid value of 10 to 30 mgKOH/g.}$$

Liptak teaches a composition for coating food cans that comprises a polyester, an acrylic copolymer and a crosslinker. (see Abstract) Liptak teaches that the acrylic copolymer is a polymer formed by combining various acrylic monomers. See page 2, paragraph [0013]. The claimed invention in contrast is directed to an acryl-modified polyester resin composition produced by a polymerization of a polyester resin and an acryl monomer, as claimed in Claims 1 and 5. Liptak also discloses an acid value of "less than about 10" mg KOH/g for the polyester resin. See p. 1, paragraph [0008].

Liptak thus specifically discloses an acid value of less than about 10 mgKOH/g for the polyester (i.e., polyester component of the composition). See p. 1, paragraphs [0006] and [0008]. This limitation clearly intends that an acid value of 10 mgKOH/g is the upper limit in Liptak,

Docket No. 21C-0106

and that an acid value for the polyester according to Liptak is less than this value, but not inclusive of it. Therefore, Liptak does not disclose an acid value *equal* to 10 mgKOH/g, as claimed in the instant claims. It has been held that “anticipation under § 102 can be found only when the reference discloses exactly what is claimed,” with regard to anticipation of ranges. *Titanium Metals Copr. V. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Liptak thus clearly fails to disclose and does not overlap an acid value for the polyester resin intermediate of 10 to 30 mgKOH/g as claimed in instant Claims 1 and 5.

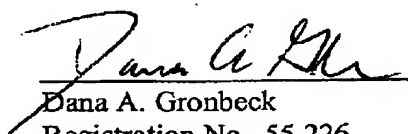
In addition, Liptak uses the term “about” as a modifier in the limitation “less than about 10 mgKOH/g”. The use of the term “about”, when coupled with a relatively precise form of measurement, has been held to be definite and may be acceptable in appropriate fact situations. *W.L. Gore & Associates., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1557 220 USPQ 303, 316 (Fed. Cir. 1983). However, in Liptak, the use of “about” in combination with “less than”, and not with “less than *or equal to*” (emphasis added) or other similar language inclusive of the stated limit (i.e., 10 mgKOH/g), must by exclude the stated limit from the anticipatory range. Further, by virtue of the use of the term “about”, the limitation “less than about 10” must therefore allow only for a reasonably precise error to encompass an undefined subrange that is by definition lower than, and not inclusive of, the limit of 10 mgKOH/g in Liptak. Thus, for at least the above reasons, the limitation “less than about 10 mgKOH/g” cannot anticipate the claimed ranges in Claims 1 and 5 of “10 to 30 mgKOH/g”. Accordingly, withdrawal of the rejection and allowance of the claims is therefore respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the objection(s) and rejection(s) and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

CANTOR COLBURN LLP

By: 

Dana A. Gronbeck
Registration No. 55,226
Confirmation No. 8080
Cantor Colburn LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone: (860) 286-2929
Fax: (860) 286-0115
PTO Customer No. 23413

Date: October 13, 2006